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09/771,564	01/30/2001	Akihiro Furukawa	108478	9409

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EXAMINER	
MEHRPOUR, NAGHMEH	
ART UNIT	**PAPER NUMBER**
2686	7

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/771,564	FURUKAWA ET AL.	
	Examiner	Art Unit	
	Naghmeh Mehrpour	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) 1-26 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) 1-26 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-5, 8-10,** rejected under 35 U.S.C. 102(e) as being anticipated by Stenman et al. (US Patent Number 6,223,029 B1).

Regarding claim 1, Stenman teaches an electric device communicable 2035 with a cellular phone 2000, comprising: a control unit 2035 that executes operations based on control data transmitted from the cellular phone 2000 (see figure 4, col 7 lines 1-26).

Regarding claim 2, Stenman teaches an electric device 2035 comprising an interface 2035 that receives the control data, the interface being connectable to a local area network which includes one of a server or a gateway, the control data is transmitted from the cellular phone 2000 to the interface via one of the server and the gateway (col 8 lines 55-67).

Regarding claim 3, Stenman teaches an electric device 2035 further comprising a communication unit 830 that receives the control data from the cellular phone 2000 (see figure 13F).

Regarding claim 4, Stenman teaches an electric device 2035 wherein the communication unit transmits an audio guidance to the cellular phone, and the control data is transmitted from the cellular phone in response to the audio guidance (Col 7 lines 52-59).

Regarding claim 5, Stenman teaches an electric device 2035 wherein the communication unit receives the control data via a Web service(see figure 8, col 13 lines 48-62).

Regarding claim 8, Stenman teaches an electric device 2035 wherein the communication unit receives the control data via a telephone line (col 6 lines 2-11).

Regarding claim 9, Stenman teaches an electric device 2035 wherein the control unit 860 includes a condition setting unit that sets an operation condition based on the control data received from the cellular phone 2000 (see figure 13F, col 12 lines 22-33).

Regarding claim 10, Stenman teaches an electric device 2035 further comprising an image forming unit for forming images, wherein the control unit 860 controls the image forming unit (printer) based on the control data receive from the cellular phone 2000 (see figures 7, 13F, col 7 lines 1-24).

3. **Claims 15-23**, are rejected under 35 U.S.C. 102(e) as being anticipated by Chapman et al. (US Patent Number 6,522,421 B2).

Regarding claim 15, Chapman teaches an image forming device 15 comprising: a receiving unit that receives data from an external device 11 by means other than e-mail (col 3 lines 18-32), the data including an e-mail address (col 3 lines 10-19); a detecting unit that detects an e-mail address from the data (col 3 lines 33-37); and an output unit that outputs an e-mail message to the e-mail address (col 3 lines 37-42).

Regarding claim 16, Chapman teaches an image forming device 15 (col 3 lines 60-62) wherein the data received from the external device 11 includes both the e-mail address and specified information (col 2 lines 58-63. col 3 lines 32-35), and detecting unit further detects the specified information from the data, and the output unit outputs the e-mail message containing information corresponding to the specified information (see figure 1, col 2 lines 63-67, col 3 lines 1-18).

Regarding claim 17, Chapman teaches a system comprising: a print data generating unit including: a generating unit that generates print data including document data and command data (col 2 lines 47-65), the command data including an e-mail address (col 3 lines 18-20); and a communication unit that transmits the print data by means other than e-mail (col 3 lines 20-32); and an image forming unit including: a receiving unit that receives the print data from the print data generating unit (col 3 lines 33-35) ; and a detecting unit that detects the e-mail address from the command data (col 3 lines 11-37).

Regarding claim 18, Chapman Stenman teaches a system according wherein the image forming unit 15 (col2 lines 45-50) further includes an e-mail unit that prepares e-mail message including a predetermined information (col 3 lines 45-62), and a transmit unit that transmits the e-mail message to the e-mail address detected by the detecting unit (col 3 lines 33-60).

Regarding claim 19, Chapman teaches the system wherein the generating unit generates the print data including the command data including both the e-mail address and specified information (col 3 lines 40-62), and detecting unit further specifies the specify information from the command data (col 2 lines 55-66), and the e-mail unit generates the e-mail message including information corresponding to the detected specify information (col 3 lines 33-37).

Regarding claim 20, Chapman teaches a system according wherein the generating unit automatically includes the specified information (error information)into the command data (col 3 lines 5-7, lines 20-32).

Regarding claim 21, Chapman teaches a control method of controlling an electric device 15, comprising the steps of: receiving data transmitted from a cellular phone; and controlling a control unit 19 of the electric device in accordance with the received data(col 9,3 lines 18-32).

Regarding claim 22, Chapman teaches a method wherein the control unit 19 changes a mode in accordance with the received data in the controlling step (col 3 lines 20-32).

Regarding claim 23, Chapman teaches a method according wherein the control unit executes an image output operation in accordance with the received data in the controlling step(col 3 lines 40-53).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 6-7, 12-13, 14**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Stenman et al. (US Patent Number 6,223,029 B1) in view Chapman (US Patent Number 6,522,421 B1).

Regarding claim 6, Stenman teaches an electric device 2035 wherein the communication unit 860 transmits and receives data and voice signals from the cellular phone(abstract). Stenman

fails to teach an electric device 2035 wherein the communication unit 860 transmits and receives e-mail messages to and from the cellular phone, and the communication unit receives the control data on the e-mail. However Chapman teaches an electric device 2035 wherein the communication unit 19 transmits and receives e-mail messages to and from telephone, and the communication unit receives the control data on the e-mail (col 3 lines 5-18. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine above teaching of Chapman with Stenman, in order to provide mail system capable of restricting the printing of a literal message .

Regarding claim 7, Stenman fails to teach an electric device 2035 wherein the control unit 860 appends an identification code to the e-mail message, and the communication unit transmits the e-mail message appended with the identification code. However Chapman teaches an electric device 15 wherein the control unit 19 appends an identification code to the e-mail message, and the communication unit transmits the e-mail message appended with the identification code (col 3 lines 18-20). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine above teaching of Chapman with Stenman, in order to provide mail system capable of restricting the printing of a literal message .

Regarding claim 12, Stenman fails to teach the electric device further comprising a detecting unit wherein the interface further receives another data from an external device by means other than e-mail, and a detecting unit that detects an e-mail address from the another data. However Chapman teaches the electric device 15 further comprising a detecting unit wherein the interface further receives another data from an external device by means other than e-mail, and a detecting unit that detects an e-mail address from the another data (col 3 lines 60-67). Therefore, it would

have been obvious to one of ordinary skill in the art at the time of the invention to combine above teaching of Chapman with Stenman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding claim 13, Stenman fails to teach an electric device wherein the interface outputs an e-mail message containing a predetermined information to the e-mail address detected by the detecting unit. However Chapman teaches an electric device 15 wherein the interface outputs an e-mail message containing a predetermined information to the e-mail address detected by the detecting unit. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine above teaching of Chapman with Stenman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding claim 14, Stenman teaches an electric device 2035 according wherein the another data including the e-mail address and request information, and the detecting unit detects the e-mail address and the request information from the another data, and the interface outputs the e-mail message including information corresponding to the request information to the e-mail address. Chapman teaches an electric device 15 according wherein the another data including the e-mail address and request information (col 3 lines 11-21), and the detecting unit detects the e-mail address and the request information from the another data (col 3 lines 33-35), and the interface outputs the e-mail message including information corresponding to the request information to the e-mail address (col 3 lines 40-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine above teaching of Chapman with Stenman, in

order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

5. **Claim 11**, is rejected under 35 U.S.C. 103(a) as being unpatentable over Stenman et al. (US Patent Number 6,223,029 B1) in view Chapman (US Patent Number 6,522,421 B1) in further view of Peyser International publication WO 94/26059.

Regarding claim 11, Stenman teaches an electric device 2035 further comprising: a connection unit that is connected to a plurality of image information generating devices that generate image information (col 4 lines 58-67, col 5 lines 1-18, lines 37-44), the connection unit receiving the image information from the image information generating devices (col 7 lines 2-24). The combination of Stenman and Chapman fails to teach a judging unit that judges whether or not the image information is confidential information, the control unit controls the image forming unit to form images based on the image information; after the communication unit receives the predetermined code. However Peyser teaches a judging unit that judges whether or not the image information confidential information, the control unit controls the image forming unit to form images based on the image information; after the communication unit receives the predetermined code (page 6 lines 13-17, page 7 lines 21-25, page 8 lines 31-35, page 9 lines 5-16). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine above teaching of Peyser to the combination of Stenman and Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

6. **Claims 24-26,** are rejected under 35 U.S.C. 103(a) as being unpatentable over Stenman et al. (US Patent Number 6,223,029 B1) in view Chapman (US Patent Number 6,522,421 B1)

Regarding claim 24, Chapman teaches a control method of controlling an image forming device, comprising the steps of:

a) receiving print data from an external device 11 (col 3 lines 29-35);

b) storing the print data in a memory(col 3 lines 35-37); and

c) executing printing of the print data when a predetermined password (user ID, col 3 lines 18) is received from a work station 11(col 3 lines 18-25), or by telephone (col 3 lines 60-67, col 4 line 1). Chapman fails to c) executing printing of the print data from a cellular phone. However Stenman teaches c) executing printing of the print data from a cellular phone (col 7 lines 1-24, col 15 lines 20-21).). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine above teaching of Stenman to Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding claim 25, Chapman teaches a controlling method comprising detecting email address from the print data. Chapman fails to teach a control method according further comprising the step of

d) detecting a telephone number from the print data,

e) making a telephone call to the detected telephone number, and

f) outputting a predetermined audio guidance urging a user of the cellular phone to input the predetermined password. Stenman teaches a method of controlling comprising the step of : mobile includes a command control module associated with various peripheral device such as printer and alarm and vibrator. The mobile can activates a personal alarm to automatically contact a predetermined number or an SMS message to a preselected party (col 7 lines 16-24,

col 15 lines 20-25), or mobile sends a command for the device to detect the DTMF tone (col 16 lines 33-35).

d) detecting a telephone number from a vibrator (col 7 lines 40-47),

e) making a telephone call to the detected telephone number (col 7 lines 16-24), and

f) outputting a predetermined audio guidance urging a user of the cellular phone to input the predetermined password (col 7 lines 47-59). The above teaching shows that the mobile is able to detect the telephone number from the cellular phone as well as .the vibrator.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine above teaching of Stenman to Chapman, in order to provide a mobile with dual functionalities such as acting as remote control unit for a variety of peripheral devices.

Regarding claim 26, Chapman teaches a control method further comprising the step of

g) detecting an e-mail address from the print data (col 3 lines10-19), and h) sending an e-mail message to the detected address (col 3 lines 20-33), Chapman teaches the e-mail message urging a user of the work station 11 input the predetermined password (col 3 lines 10-19, lines 1-35). Chapman does not teaches the user controls the device via a cellular phone. However Stenman teaches a controlling method that user controls the device via cellular phone. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine above teaching of Stenman to Chapman, in order to enable the mobile to provide dual functionalities , and operates as a cellular phone and a remote control unit for a variety of peripheral devices.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Toyoda (US Patent Number 6,094,277) disclose internet facsimile apparatus and Email communication method

Bentley (US Patent Number 6,591,094) disclose automated user notification

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naghmeh Mehrpour whose telephone number is 703-308-7159. The examiner can normally be reached on 8:00- 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bank-Harlod Harold Marsha can be reached on 703-308-5001. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-5000.

Marsha D Banks-Harold

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NM
September 4, 2003